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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,479	02/02/2001	Guy Leclerc	50018 CIP	8765

7590

10/03/2002

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

BEST AVAILABLE COPY

Office Action Summary	Application No. 09/775,479	Applicant(s) LECLERC ET AL.	
	Examiner David Lambertson	Art Unit 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 12, 14, 15, 18, 19 and 21, drawn to an anti-proliferative substance comprising a sense nucleic acid conjugated to an antibody, classified in class 536, subclass 22.1.
- II. Claims 1-8, 10, 12, 14, 15, 18, 19 and 21, drawn to an anti-proliferative substance comprising a sense nucleic acid conjugated to a protein molecule, classified in class 536, subclass 22.1.
- III. Claims 1-8, 10, 12, 14, 15, 18, 19 and 21, drawn to an anti-proliferative substance comprising a sense nucleic acid conjugated to a lipid molecule, classified in class 536, subclass 22.1.
- IV. Claims 1-9, 11-15 and 18-20, drawn to an anti-proliferative substance comprising an antisense nucleic acid conjugated to an antibody, classified in class 536, subclass 24.5.
- V. Claims 1-8, 10-15 and 18-20, drawn to an anti-proliferative substance comprising an antisense nucleic acid conjugated to a protein molecule, classified in class 536, subclass 24.5.

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- VI. Claims 1-8, 10-15 and 18-20, drawn to an anti-proliferative substance comprising an antisense nucleic acid conjugated to a lipid molecule, classified in class 536, subclass 24.5.
- VII. Claims 16 and 17, drawn to a method for preparing a radiolabeled DNA carrier, classified in class 536, subclass 25.3.
- VIII. Claims 22-26, drawn to a method for preventing uncontrolled cell proliferation, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups I-VI are each unrelated to the other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions functions. The anti-proliferative substance comprising a sense nucleic acid conjugated to an antibody (Group I), anti-proliferative substance comprising a sense nucleic acid conjugated to a protein molecule (Group II), anti-proliferative substance comprising a sense nucleic acid conjugated to a lipid molecule (Group III), anti-proliferative substance comprising an antisense nucleic acid conjugated to an antibody (Group IV), anti-proliferative substance comprising an antisense nucleic acid conjugated to a protein molecule (Group V) and the anti-proliferative substance comprising an antisense nucleic acid conjugated to a lipid molecule (Group VI) are unrelated to each other because they have different structures and functions, either in terms of the sequence of the nucleic acid (as sense or antisense) or the molecule to which the nucleic acid is conjugated.

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the sequences listed in claim 13 are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, a single independent and distinct nucleotide sequence will be examined in a single application.

Claim 13 specifically claims antisense SEQ ID NOS 1-4 and 8-11. The instant antisense sequences are considered to be unrelated since each antisense sequence claimed is structurally and functionally independent and distinct for the following reasons: each antisense sequence has a unique nucleotide sequence and each antisense sequence targets a different and specific nucleic acid. Furthermore, a search of more than one (1) of the antisense sequences claimed in 13 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed antisense sequences. In view of the foregoing, one (1) antisense sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicant is required to elect one (1) antisense sequence when electing a group as set forth above.

Inventions Groups I-VI and Group VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made using a materially different process, such as oligomer

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synthesis without hybridization. Therefore, a search of one group would not be coextensive with a search of the other hence said search would be burdensome.

Inventions Groups I-VI and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process can be practiced using a materially different product, such as a chemotherapeutic agent or a pharmacological agent. Therefore, a search of one group would not be co-extensive with the search of another hence said search would be burdensome.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and so on, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson
August 1, 2002

DAVID GUZO
PRIMARY EXAMINER
